

ESTTA Tracking number: **ESTTA771154**

Filing date: **09/16/2016**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	EBB Development Limited
Granted to Date of previous extension	09/17/2016
Address	207 Regent Street, 3rd Floor London, W1B3HH UNITED KINGDOM
Attorney information	Roman A. Popov Morton & Associates LLP 246 West Broadway, 4th Floor New York, NY 10013 UNITED STATES rp@mortonassociates.com Phone:(212) 796 4309

Applicant Information

Application No	86906603	Publication date	07/19/2016
Opposition Filing Date	09/16/2016	Opposition Period Ends	09/17/2016
Applicant	Expensify, Inc. 88 Kearney St., Suite 1600 San Francisco, CA 94104 UNITED STATES		

Goods/Services Affected by Opposition


Class 009. First Use: 0 First Use In Commerce: 0

All goods and services in the class are opposed, namely: Downloadable computer software for automating business processes and employing optical character recognition (OCR) software for expense reporting, expense management, itinerary management, meeting management, vendor payment management, purchasing management, sales force management, customer service, financial reporting, marketing, and preparing sales projections; Downloadable mobile applications employing optical character recognition (OCR) software for use in online personal and business process automation for sales, financial management, itinerary management, expense accounting, expense reporting and marketing; Downloadable mobile application employing optical character recognition (OCR) software for enabling data synchronization and enabling predictive analysis and communications about data including receipts relating to automation of personal and commercial business processes, namely, expense management including receipt management and itinerary management

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
--------------------------------------	----------------------------

Mark Cited by Opposer as Basis for Opposition

U.S. Application No.	87131390	Application Date	08/08/2016
Registration Date	NONE	Foreign Priority Date	02/12/2016
Word Mark	CONCIERGE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 0 First Use In Commerce: 0 Computer hardware; software; computer peripherals; electronic data processing installations; computer network apparatus; parts and fittings for all the aforesaid goods		

Attachments	87131390#TMSN.png(bytes) Notice.Opposition.9.16.16.pdf(115168 bytes)
-------------	--

Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/s/ Roman A. Popov
Name	Roman A. Popov
Date	09/16/2016

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

EBB DEVELOPMENT LIMITED,

Opposer,

v.

EXPENSIFY, INC.,

Applicant.

Opposition No.

Serial No. 86/906,603

Mark: CONCIERGE

Filing Date: February 12, 2016

Publication Date: July 19, 2016

NOTICE OF OPPOSITION

Pursuant to 37 C.F.R. §2.101, EBB Development Limited, a company duly organized and existing under the laws of United Kingdom, with a principal place of business at 3rd Floor 207 Regent Street, London, W1B3HH United Kingdom (hereinafter “Opposer”), believes that it will be damaged by the registration of the mark CONCIERGE in International Class 9, which is the subject of U.S. Trademark Application Serial No. 86/906,603, filed by Expensify, Inc., a corporation existing under the laws of the State of Delaware with a principal place of business at 88 Kearney St., Suite 1600, San Francisco, CA, United States 94104 (“Applicant”), on February 12, 2016 and hereby opposes the same.

As grounds for this opposition, Opposer alleges the following:

1. Upon information and belief, Applicant filed to register the mark “CONCIERGE” (“Applicant’s Mark”), assigned Application Serial No. 86/906,603, with the United States Patent and Trademark Office on February 12, 2016, for use in connection with International Class 9 goods, namely, “downloadable computer software for automating business processes and employing optical character recognition (OCR) software for expense reporting,

expense management, itinerary management, meeting management, vendor payment management, purchasing management, sales force management, customer service, financial reporting, marketing, and preparing sales projections; downloadable mobile applications employing optical character recognition (OCR) software for use in online personal and business process automation for sales, financial management, itinerary management, expense accounting, expense reporting and marketing; downloadable mobile application employing optical character recognition (OCR) software for enabling data synchronization and enabling predictive analysis and communications about data including receipts relating to automation of personal and commercial business processes, namely, expense management including receipt management and itinerary management” (the “Applicant’s Application”).

2. Upon information and belief, the Applicant’s Application was published for opposition in the Official Gazette on July 19, 2016.
3. On August 16, 2016, Opposer timely filed a 30-day Request for Extension of Time to File Opposition, which was subsequently granted and the Opposition Period was extended to September 17, 2016.
4. Opposer timely filed a Section 44(d) application accorded U.S. Serial No. 87/131,390, for the mark “CONCIERGE” on August 8, 2016 for goods in International Class 9, namely, “computer hardware; software; computer peripherals; electronic data processing installations; computer network apparatus; parts and fittings for all the aforesaid goods” (hereinafter “Opposer’s U.S. Application”).

5. Opposer's U.S. Application is based on its prior filing, accorded Application No. 410238, with the Intellectual Property Organization of Pakistan, on February 12, 2016.
6. Applicant's Application was electronically filed with the USPTO on February 12, 2016 at 15:58:47 EST.
7. Despite the fact that Opposer also filed its Pakistan Application on February 12, 2016, Pakistan is 9 hours ahead of Eastern Standard Time, meaning that by the time Applicant filed its Application, it was already 00:58:47, February 13, 2016 in Pakistan.
8. As such, Opposer asserts a valid claim of priority pursuant to Article 4 of the Paris Convention.
9. The basis of this opposition is the likelihood of confusion that exists between Applicant's and Opposer's Marks. Both Applicant's and Opposer's Marks are identical to one another, composed only of the word CONCIERGE. There are no differentiating factors.
10. Applicant's CONCIERGE Mark incorporates Opposer's CONCIERGE Mark in its entirety and is identical in sight, sound, meaning and commercial impression.
11. The similarity between the two Marks engenders a high likelihood that customers with only a general recollection of Opposer's mark will confuse products as emanating from the same source when they encounter the Marks separately in the marketplace.

12. Applicant's Mark is intended to be used in connection with similar and/or identical goods as those outlined in Opposer's Application. It is indisputable that the essence of both Applicant's and Opposer's goods, in International Class 9, is computer software.
13. The likelihood of confusion is amplified by the fact that there is a direct overlap between some of the Applicant's goods and the Opposer's goods in International Class 9.
14. Furthermore, the goods in Applicant's Application are within the natural zone of expansion of the goods enumerated in Opposer's Application.
15. Certainly, it is reasonable posit that Opposer will expand use of its mark in commerce from, *inter alia*, "computer software" to "downloadable computer software for automating business processes and employing optical character recognition (OCR) software for expense reporting, expense management, itinerary management, meeting management, vendor payment management, purchasing management, sales force management, customer service, financial reporting, marketing, and preparing sales projections; downloadable mobile applications employing optical character recognition (OCR) software for use in online personal and business process automation for sales, financial management, itinerary management, expense accounting, expense reporting and marketing; downloadable mobile application employing optical character recognition (OCR) software for enabling data synchronization and enabling predictive analysis and communications about data including receipts relating to automation of personal

- and commercial business processes, namely, expense management including receipt management and itinerary management”.
16. Upon information and belief, the Applicant has yet to use its Mark in commerce in connection with any of the International Class 9 goods enumerated within its Application.
 17. It follows, therefore, that Applicant’s Mark has yet to acquire distinctiveness through use in commerce in connection with Applicant’s enumerated International Class 9 goods, to the level that it would deserve protection as a common law trademark.
 18. Opposer submits that it would be unjust if Applicant’s Application were to issue to registration, as it would enable Applicant to raise questions as to Opposer’s use of its Mark, as well as give the Applicant a prima facie exclusive right to use Applicant’s Mark in connection with its enumerated International Class 9 goods, despite there being no such apparent use and Opposer having priority.
 19. Registration should be refused pursuant to Section 2(d) of the Trademark Act of 1946, as amended, 15 U.S.C. § 1052(d), on the grounds that Applicant’s Mark so resembles Opposer’s Mark as to cause confusion, mistake and/or deception, all to the damage of Opposer.
 20. Based on the foregoing, Opposer will be damaged by Applicant’s use of the CONCIERGE Mark if the Application is permitted to proceed to registration.

WHEREFORE, Opposer, by its undersigned counsel of record, respectfully requests Application Serial No. 86/906,603 be refused and that the Trademark Trial and Appeal Board grant any and all further relief to Opposer that the Board finds necessary and just under the circumstances.

Dated: New York, New York
September 16, 2016

Morton & Associates LLP

By: 
Roman A. Popov, Esq.
Attorneys for Opposer
246 West Broadway, 4th Floor
New York, NY 10013
Telephone: (212) 796 4309
Facsimile: (212) 656 1828
rp@mortonassociates.com

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing NOTICE OF OPPOSITION, have been served on Applicant's attorney of record, by mailing said copy on September 16 2016, via USPS First Class Mail, postage prepaid to:

Michael K. Bosworth, Esq.
IPxLaw Group LLP
2901 Moorpark Ave., Ste 255
San Jose, California, 95128

Dated: New York, New York
September 16, 2016

By: 
Roman A. Popov, Esq.